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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,354	01/30/2001	Paul J. Rank	30014200.1080/PJLM	2393

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EXAMINER	
NGUYEN, MAIKHANH	

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/774,354	RANK ET AL.	
	Examiner	Art Unit	
	Maikhanh Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 09/14/2005 to the original application filed 01/30/2001.

2. Claims 1-18 are currently pending in this application. Claims 1 and 10 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-4 and 10-13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Horie et al.** (U.S. 6,487,597 – issued 08/1999) in view of **Schlafly** (U.S. 5,471,612 – issued 11/1995, as cited by Applicant's IDS).

As to claim 1

a. Horie teaches a method in a data processing system for a spreadsheet file comprising:

(i) obtaining said spreadsheet file in a first format on a first device *(selecting the range of a part of a character strings ...a screen of the personal computer; col.2, lines 7-9 & col.6, lines 6-8)*;

(ii) converting the spreadsheet file to a second format *(convert a file form to a new one; col.7, lines 27-30)*; and transferring the spreadsheet file to a second device *(commanding transmission of the specified range of any part of data to the personal digital assistant ... creating a new file including the specified range of any part of data for transmitting the file via connecting means to the personal assistant; col.2, lines 37-52 & col.7, lines 22-35).*

b. Horie, however, does not specifically teach "evaluating one or more formulas."

c. Schlafly teaches evaluating one or more formulas *(Formula Evaluator ... compiling spreadsheet formulas; Abstract & col.13, lines 5-6).*

d. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Horie with Schlafly because it would have provided increased the speed of transmission of the spreadsheet from the personal computer to the personal digital assistant.

As to claim 2

Horie teaches the first device is a computer *(a personal computer 10; col.4, lines 1-2 & Fig.1).*

As to claim 3

Horie teaches the second device is a small device *(PDA 13; col.4, line 5 and Fig.1).*

As to claim 4

Horie teaches the small device is a PDA *(PDA 13; col.4, line 5 and Fig.1).*

As to claim 10

It directed to a computer program product for performing the method of claim 1 above, and is rejected along the same rationale.

As to claims 11-13

They incorporate substantially similar subject matter as in claims 2-4 above, and are rejected along the same rationale.

5. Claims 5-9 and 14-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Wright et al.** in view of **Schlafly** as applied to claims 1 and 10 above, and further in view of **Pajakowski et al** (U.S. 6,718,425 – field 05/2000).

As to claim 5

a. The combination of Horie and Schlafly does not specifically teach "the converting is performed by a conduit."

b. Pajakowski teaches the converting is performed by a conduit *(conduit software ... to convert; col.46, lines 55-64).*

c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pajakowski's teachings with Horie as modified

by Schlafly because it would have provided the enhanced capability for translating and moving data from one computer to another computer.

As to claim 6

a. Horie does not specifically teach "gathering the one or more formulas."

b. Schlafly teaches gathering the one or more formulas *(col.15, lines 1-30).*

c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Horie with Schlafly because it would have provided the capability for improving the speed with which electronic spreadsheets perform recalculation of spreadsheets.

As to claim 7

a. Horie does not specifically teach "evaluating the formulas by the conduit."

b. Schlafly teaches evaluating the formulas *(Formula Evaluator ... compiling spreadsheet formulas; Abstract).* Schlafly, however, does not specifically teach the use of conduit.

c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Horie with Schlafly because it would have increased the speed of transmission of the spreadsheet from the personal computer to the personal digital assistant.

d. Refer to discussion of claim 5 above for rejection of "conduit".

As to claim 8

a. Horie teaches compiling code that is readable by a small device *(col.7, lines 36-52).*

As to claim 9

a. Horie does not specifically teach "parsing the formulas."

b. Schlafly teaches parsing the formulas *(Abstract)*.

c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Horie with Schlafly because it would have increased the speed of transmission of the spreadsheet from the personal computer to the personal digital assistant.

As to claims 14-18

They incorporate substantially similar subject matter as in claims 5-9 above, and are rejected along the same rationale.

Response to Arguments

6. Applicant's arguments filed 09/14/2005 have been fully considered but they are not persuasive.

Applicant argues that the combination of Horie and Schlafly fails to teach evaluating formulas while coverting the spreadsheet file. (Remarks, page 6, 2nd paragraph)
In response, the Examiner believes that the combination of Horie and Schlafly meets the limitations as claimed by Applicant. Horie teaches converting the spreadsheet file (convert a file; col.7, lines 27-30 – it is noted that a file is a spreadsheet file; see col.6,

lines 39-40). Schlafly teaches evaluating formulas (Abstract & evaluating and compiling formulas in an electronic spreadsheet; col.13, lines 5-6).

Applicant argues that the Examiner fail to establish a motivation to combine the references as proposed. (Remarks, page 6, last paragraph)

In response, Examiner notes that the test for the relevance of a cited combination of references is: "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ2d at 1888. Subject matter is unpatentable under section 103 if it would have been obvious ... to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination: *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)." Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979). "In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference." *In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992).

Applicant argues that *Horie never discloses a formula in need of evaluation. Indeed, the*

word "formula" does not event appear in the text of the patent. (Remarks, page 6, last paragraph)

In response, Applicant is arguing the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642F. 2d 413, 208 USPQ 871 (CCPA 1981); In re Merc# & Co., 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir.1986). Applicant obviously attacks references individually without taking into consideration based on the teaching of combinations of references as shown above. The rejection above shows Schlafly is used to teach evaluating formulas.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Robertson	U.S. Publication 2001/00479441 A1	Pub. Date: Nov. 29, 2001
Liu	U.S. Publication 2002/0065939 A1	Pub. Date: May 30, 2002

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

William L. Bashore

WILLIAM BASHORE
PRIMARY EXAMINER

11/2/2005